

REMARKS:

Applicant thanks the Examiner for the Office Action dated October 4, 2007. After entry of this Amendment, claims 1-3, 10-13, and 20-24 are pending in the subject application. Claims 1 and 11 have been amended. Reconsideration of the application as amended is respectfully requested.

The Examiner rejected claims 1, 2, 11-12, 14, 21, and 23 under 35 U.S.C. §102(e) as being anticipated by Prater et al., United States Patent No. 6,641,742. The Examiner stated that Prater discloses a housing 26, a filter element disposed between an inlet and an outlet, an impervious cover 50, and a relief valve 102.

Applicant respectfully notes that Prater is a low-pressure application in that a fuel pump is placed on the suction side of the filter (Col. 1, lines 59-60). Thus, the spacing between the cover and the filter element is not critical as the fuel level slowly rises within the housing as contamination of the filter element increases. Therefore, the cover has a tapered structure, wherein the size and clearances are not identified in the specification of the patent. Applicant's invention is a high-pressure application where the pump is upstream from the filter (pg. 2), thereby making the size and clearance of the cover critical. If the size and clearance of the cover were not carefully designed, the housing would immediately fill with fluid, and the fluid level could not be used to monitor filter wear. Thus, Applicant has amended the claims to call for the pump to be upstream of the filter and to specifically define the shape of the cover.

With regard to claim 1 and its dependent claims, Applicant has amended claim 1 to recite a bottom portion with a substantially continuous first inner diameter defined throughout the bottom portion and an upper portion having a substantially continuous second diameter defined throughout the upper portion wherein the second inner diameter is smaller than the first inner diameter. Claim 1 has also been amended to state that the bottom portion extends at least from a bottom end of the filter

element to a fluid impervious region of the filter element and that the upper portion extends from a top end of the filter element to the bottom portion.

Applicant's specification teaches that the difference in diameter between the bottom portion and the upper portion of the outer cover is critical in that it defines a pocket of trapped air and thus allows the fluid level in the upper portion of the housing to serve as a visual indicator as to the condition of the filter element under high pressure conditions. If the area between the outer cover and filter element is too large, the housing will completely fill with fluid under high-pressure conditions, thereby preventing the fluid level from being used as a visual indicator as to the condition of the filter element. Applicant respectfully submits that the invention stated in claim 1, as amended, is not disclosed by the references of record.

With regard to claim 11 and its dependent claims, claim 11 has been amended to include the steps of establishing a lower predetermined volume and establishing an upper predetermined volume. The lower predetermined volume is defined in claim 11 as being between the bottom portion of the outer cover and the filter element, wherein the bottom portion has a substantially continuous first inner diameter and extends at least from the bottom end of the filter element to the fluid impervious region of the filter element. The upper predetermined volume is defined in claim 11 as being between the upper portion of the outer cover and the filter element, wherein the upper portion has a substantially continuous second inner diameter that is smaller than the first inner diameter. The upper portion extends from the top end of the filter element to the bottom portion. Applicant respectfully submits that the invention stated in claim 11, as amended, is not shown or described by the references of record.

In light of the foregoing, Applicant respectfully requests that the rejection of claims 1, 2, 11-12, 14, 21, and 23 under 35 USC 102(e) be withdrawn.

The Examiner next rejected claim 17 under 35 U.S.C. §102(e) as being anticipated by Prater et al. in view of Smith et al., United States Patent No. 6,841,065.

Applicant notes that claim 17 depends from claim 11. Thus, Applicant respectfully submits that the invention stated in claim 17 is not shown or described by the references of record, as previously explained with regard to claim 11. Accordingly, Applicant respectfully requests that the rejection of claim 17 under 35 USC 102(e) be withdrawn.

The Examiner next rejected claims 1-2, 11-12, and 14-19 under 35 U.S.C. §103(a) as being unpatentable over Cooper, United States Patent No. 3,508,657 in view of Prater et al. The Examiner stated that Cooper teaches a filter apparatus including an inlet 5, an outlet 6, a filter element 10, a relief valve, and a transparent cap 73. The Examiner then stated that Prater teaches a filter including an outer cover and transparent housing for observing the level of fluid in the housing. The Examiner then concluded that it would have been obvious to combine the teachings of Cooper and Prater.

Applicant respectfully submits that the combination of Cooper with Prater does not cure the deficiencies of Prater with regard to amended claims 1 and 11, as previously explained in connection with the rejection of claims 1 and 11 under 35 USC 102(e). Accordingly, Applicant respectfully requests that the rejection of claims 1-2, 11-12, and 14-19 under 35 U.S.C. §103(a) be withdrawn.

The Examiner next rejected claims 3 and 13 under 35 U.S.C. §103(a) as being unpatentable over Prater et al. in view of Jiang et al., United States Patent No. 6,939,464.

Applicant notes that claims 3 and 13 depend from claims 1 and 11, respectively. Thus, claims 3 and 13 should be allowable in light of the amendments to claims 1 and 11, as well as for the further limitations as stated in claims 3 and 13 themselves. Accordingly, Applicant respectfully requests that the rejection of claims 3 and 13 under 35 U.S.C. §103(a) be withdrawn.

The Examiner next rejected claims 10 and 20 under 35 U.S.C. §103(a) as being unpatentable over Prater et al. in view of Robinson et al., United States Patent No. 6,039,030.

Applicant notes that claims 10 and 20 depend from claims 1 and 11, respectively. Accordingly, claims 10 and 20 should be allowable in light of the amendments to claims 1 and 11, as

well as for the further limitations stated in claims 10 and 20 themselves. Accordingly, Applicant respectfully requests that the rejection of claims 10 and 20 under 35 U.S.C. §103(a) be withdrawn.

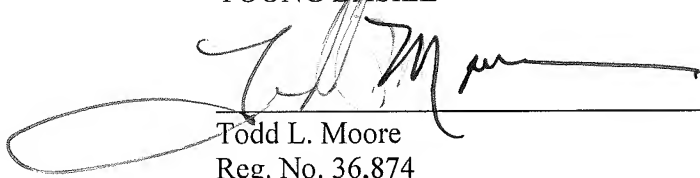
The Examiner next rejected claims 22 and 24 under 35 U.S.C. §103(a) as being unpatentable over Prater et al. The Examiner stated that the claimed relative dimensions were considered obvious in light of Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), where the Federal Circuit held that relative dimensions are not patentable distinctions where the claimed invention does not perform differently than the prior art device.

Applicant first notes that claims 22 and 24 depend from claims 1 and 11, respectively, and thus should be allowable based on the amendments to claims 1 and 11. However, Applicant notes that the Examiner has made no explicit finding that the claimed invention would not perform differently than the apparatus shown in the Prater reference, as required by the Gardner decision. In fact, as Applicant has explained previously, the relative dimensions of the upper portion and the lower portion, which are directly related to the clearance values, are critical in that they allow the fluid level within the housing to serve as an indication as to the condition of the filter in high-pressure operation. As also explained in Applicant's specification, prior filter assembly designs, such as the one shown in Prater, do not provide an indication as to the condition of the filter element under high-pressure operation, as the fluid level within the housing would rise to the top of the housing immediately when the filter is clean. Thus, the apparatus of Prater does not perform in the manner that the claimed invention does, and thus, the rejection of claims 22 and 24 under 35 U.S.C. §103(a) is improper. Accordingly, Applicant respectfully requests that the rejection of claims 22 and 24 under 35 U.S.C. §103(a) be withdrawn.

In light of the amendments and comments made herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections to the claims and allow the subject application to proceed to issuance.

If the Examiner has any questions regarding this matter, the Examiner may contact
Applicant's undersigned Attorney at (734) 662-0270.

Respectfully Submitted,
YOUNG BASILE



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